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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,943

02/14/2002

Rolando Moreno

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5273

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7590

05/12/2005

BIRCH STEWART KOLASCH & BIRCH

PO BOX 747

FALLS CHURCH, VA 22040-0747

EXAMINER

CANFIELD, ROBERT

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,943

Applicant(s)

MORENO, ROLANDO

Examiner

Robert J Canfield

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 is/are allowed.
- 6) ☒ Claim(s) 1,8-16 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 2-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/24/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. This Office action is in response to applicant's response filed 02/08/05. Claims 1-16 and 19-22 remain pending. Claims 17 and 18 have been canceled.

2. The examiner acknowledges receipt of the IDS filed 02/24/05. An initialed copy of the 1449 form is attached.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

4. Claims 1, 8-16 and 19-21 are rejected under 35 U.S.C. 102(d) as being barred by applicant's ES 2,156,525.

The ES patent has a filing date of 01/15/1999, which is more than a one year prior to the effective filing date 02/14/2002 of the instant application.

The ES patent was published on 06/16/2001, which is prior to the effective filing date 02/14/2002 of the instant application.

Both the ES patent and instant application have the same inventor.

The ES patent provides a stone cladding system including a plurality of stone cladding panels (5), support rails (4), spaced apart mullions (1), L-shaped (figures 5 and 8) clips (9) and anchor brackets (3). The clips (9) are shown and described as being for snap engagement (column 5, line 56) with an upper rail

(6) and having a retaining arm (42) engaged within slot (43) in the top edge of panel (8).

5. Claims 1, 8-16 and 19-21 are rejected under 35 U.S.C. 102(d) as being barred by applicant's EP 1,172,500.

The EP patent has a filing date of 07/14/2000, which is more than a one year prior to the effective filing date 02/14/2002 of the instant application.

The EP patent was published on 01/16/2002, which is prior to the effective filing date 02/14/2002 of the instant application.

Both the EP patent and instant application have the same inventor.

The EP patent provides a stone cladding system (1) including a plurality of stone cladding panels (8), support rails (6), spaced apart mullions (2), L-shaped (column 6, line 1) clips (9) and anchor brackets (3). The clips (9) are shown and described as being for snap engagement (column 5, line 56) with an upper rail (6) and having a retaining arm (42) engaged within slot (43) in the top edge of panel (8).

6. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 22 is allowed.

8. Applicant's arguments filed 02/08/05 have been fully considered but they are not persuasive.

Applicant argues that the ES disclosure is not sufficient to support a 102(d) rejection of the claims. Particularly, that the last paragraph of claim 1 requires that the clips (9) have two ends, namely an inner end for snap engagement with an upper rail and an outer end engageable with a slot extending along the top edge of the cladding panel.

Figures 5 and 8 both clearly show L-shaped clips with inner and outer ends. Figure 1 shows clip 9 having an inner end engaged with rail 4 and an outer end within a slot in the top edge of a panel 5. The description of the Stone Clip on the second page of the translation provided by applicant recites

"An extruded aluminum clip (resilient clip) designed to insert into top kerf of the stone and to snap (interlock) into horizontal extrusion."

Under 102(d) the claims need not be identical. The bar applies regardless whether the foreign patent contains claims to less than all aspects of the invention. Each of the ES and EP disclosures as a whole fully disclose the inventions of claims 1, 8-16 and 19-21.

9. At least Figures 1-8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. The figures are identical to those in ES 2,156,525 A1. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

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application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 571-272-6440. The examiner can normally be reached on M-Th:

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield
Primary Examiner
Art Unit 3635



05/10/05